



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,707	05/24/2004	Tracey R. Thomas	57824.0500	3706

66170 7590 04/15/2010

Snell & Wilmer L.L.P. (AMEX)
ONE ARIZONA CENTER
400 E. VAN BUREN STREET
PHOENIX, AZ 85004-2202

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 04/15/2010

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 02/116/2010. The submission, however, is not fully responsive to the prior Office Action in view of the following.

RCE Submission Not Fully Responsive

MPEP 701, subsections V and VI state:

V...“Any submission that is an amendment ***must** comply* with the manner of making amendments as set forth in 37 CFR 1.121. See MPEP § 714.03. The amendment must include markings *showing the changes relative to the last **entered** amendment*. Even though previously filed unentered amendments after final may satisfy the submission requirement under 37 CFR 1.114(c), applicants are encouraged to file an amendment at the time of filing the RCE that incorporates all of the desired changes, including changes presented in any previously filed unentered after final amendments, accompanied by instructions not to enter the unentered after final amendments.”

VI...If the submission is a bona fide attempt to provide a complete reply, applicant should be informed that the submission is not fully responsive to the final Office action, along with the reasons why, and given a new shortened statutory period of one month or thirty days (whichever is longer) to complete the reply. See 37 CFR 1.135(c). Form paragraph 7.42.08 set forth below should be used.

Situations where a submission is not a fully responsive submission, but is a bona fide attempt to provide a complete reply are:

- (A) Non-compliant amendment - An *RCE filed with a submission which is an amendment that is not in compliance with 37 CFR 1.121*, but which is a bona fide attempt to provide a complete reply to the last Office action, should be

Art Unit: 3691

treated as a proper RCE and a Notice of Noncompliant Amendment should be mailed to the applicant. Applicant is given a time period of one month or thirty days from the mailing date of the notice, whichever is longer, to provide an amendment complying with 37 CFR 1.121. See MPEP § 714.03 for information on the amendment practice under 37 CFR 1.121.

In view of the above, Applicant's claims submitted 02/16/2010 present further amendments to *unentered* amendments [see Advisory Action of 02/09/2010] in lieu of (a) using the unentered amendment of 01/25/2010 as his/her RCE submission or (b) presenting an RCE submission which shows all changes relative to the last *entered* amendment of 07/27/2009.

Potential New Matter - 35 U.S.C. §112-1st Paragraph

In efforts of constructive prosecution with respect to Applicant's pending RCE submission, Examiner currently makes of record potential new matter concerns in view of Applicant's claim amendments of 01/25/2010 and 02/16/2010.

As per Claims 1, 16 & 17, Examiner fails to see supportive disclosure for at least the following:

1. "determining...in response to said savings amount being transferred, a plurality of penalties". Here, in view of Applicant's Specification, it appears that Applicant's system, via a debt analyzer, reviews user debt information to provide recommendations: (a) related to the prioritization or hierarchy for paying certain bills, (b) related to the amount to pay for each bill and (c) related to the user goal, based upon user goal information, user debt information and available user income. [see paragraph 48]. Although Applicant's "system may recommend prioritizing bills"

Art Unit: 3691

[paragraph 49 & (a) above] based on "high penalties" [paragraph 49], the disclosure appears to fall short of indicating *penalties determined in response to the transfer of a savings amount* as currently claimed. Here, Examiner assumes that Applicant's use of "in response to" is referencing some automatic feature of Applicant's invention since the explicit phrase "in response to" is absent from Applicant's original disclosure. Nevertheless, Applicant's "automatic mode", at best suggests concurrent transfers [paragraph 50, "upon the user accepting...the recommendations, the system automatically transfers the payment to the user savings account and to the payment of bills"] and Applicant's "partial automatic mode", at best suggests a sequential transfer that is not automatic, but requires user approval [see *Id.*, "automatically direct a payment to the user savings account, while requiring the system to provide a recommendation and waiting for user approval", i.e. system provides a hierarchy recommendation (e.g., (a) above) but it is not explicitly disclosed when, temporally, the recommendation was "determined"].

2. "determining...in response to said determining said plurality of penalties, a payment hierarchy to minimize said plurality of penalties". First, Applicant appears to suggest it inherent that his/her system "determines" bill penalties. Examiner disagrees. Associated penalties could, for the sake of argument, be provided in the registration phase as user debt information. [paragraph 43]. Stated more simply, Applicant appears to be silent with respect to how and by what, in particular, bill penalties are determined, but merely indicates a prioritization or hierarchy based on "high penalties for late payments" [paragraph 49]. Next, Examiner questions explicit support for

Art Unit: 3691

determining a payment hierarchy to minimize penalties. Here, Applicant falls short of indicating a system prioritization or hierarchy geared explicitly toward the intended use of minimizing penalties [see paragraph 49, i.e. rankings based only on “high penalties for late payments” may not minimize penalties if “large penalties” for paying less than the minimum due exist.].

As such, although not currently rejected under §112-1st paragraph, Examiner requests (a) explicit support, from Applicant's original disclosure, with respect to said limitations, or (b) further claim amendments within Applicant's original disclosure, in response to this notice.

Conclusion

Since Applicant's submission of 02/16/2010 appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period for reply supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Scarito whose telephone number is (571) 270-3448. The examiner can normally be reached on M-F (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John D. Scarito/
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691